

Remarks

Information disclosure statement

1. Applicant notes the Examiner's opinion that the IDS filed 10/28/2005 is deficient insofar as copies of EP0126833A1, AU648675B and FR2762302A1 were not filed with the IDS. These three documents were listed in the International search report. As noted in the document accompanying the IDS filed on 10/28/2005, Applicant's agent stated that he understood that copies of the prior art documents in an EPO (as ISA) search report are normally provided to the US Designated Office by the International Bureau, and therefore these copies were not enclosed on 10/28/2005. Applicant's agent offered to provide copies if needed, but has not received any request for copies.
2. Nevertheless, referring to the first sentence of paragraph 1 of the office action, Applicant is grateful to note that the references cited in the Search Report 10/28/2005 (i.e. the International search report) have indeed been considered by the Examiner. Applicant assumes that the documents have been considered as a result of them being listed in the International search report and copies of them being available to the Examiner.
3. Applicant's agent notes that copies of EP0126833A1, AU648675B and FR2762302A1 have not been included in the PAIR record for this application. Copies are enclosed herewith in case they may be of use.
4. Applicant acknowledges and apologises for the misprint in the IDS of the patent number for US3992795 and is grateful to the examiner for correcting the misprint.

Claim rejections – 35 USC 103

Claim 1

5. Independent claim 1 has been rejected as being obvious from Rettig in view of Heimann. Applicant submits that claim 1 as previously presented was not obvious from Rettig in view of Heimann. However, an amendment has been made to claim 1 as currently presented to distinguish claim 1 more clearly from Rettig in view of Heimann.

6. The Examiner has suggested that Rettig fails to disclose the feature of claim 1 that the back of the strip is self-adhesive. Applicant points out particularly with reference to Figure 4 and column 2, lines 35-39 of Rettig that the telephone number holder 10 of Rettig is attached to the handset of the telephone by an adhesive strip 35, which consists of a layer of adhesive 36 and a wax-like protective cover 38. Strip 35 is applied to the back of lower layer 22 with the cover 38 outermost.

7. Applicant concurs with the Examiner that Rettig fails to disclose the features of claim 1 of "means defining lines between adjacent pockets along which those pockets can be readily separated, the back panels being sufficiently brittle that they can readily be snapped apart along the separation lines."

8. In alleging obviousness, Applicant submits that there must be a demonstrable reason as to why the skilled person would wish to modify the prior art so as to meet the terms of the claim. Applicant submits that there is no such reason.

9. First, the holder of Rettig is designed to be stuck to a telephone handset. Applicant submits that all telephone handsets are generally the same size, and that the skilled person would see no need to change the size of the holder of Rettig by facilitating the removal of one or more of the pockets.

10. Furthermore, Applicant submits that different telephone handsets have different curvatures. The holder of Rettig needs to conform to the curvature of the handset first so that it can stick satisfactorily to a particular handset and second so that it is comfortable in the hand of the telephone user. Applicant submits that, if the holder of Rettig were brittle and therefore necessarily rigid or semi-rigid, different versions of the holder of Rettig would need to be manufactured for different curvatures of handset, which would severely complicate the manufacture, selling and purchasing of the holders. Applicant therefore submits that the skilled person would steer away from modifying the holder of Rettig so that it, or any part of it, is brittle.

11. In alleging obviousness by combining prior art teachings, Applicant furthermore submits that the combination must result in the claimed subject matter. Applicant submits the combination of Rettig and Heimann does not result in the arrangement as claimed in claim 1.

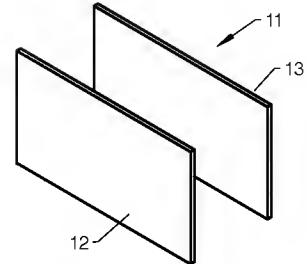
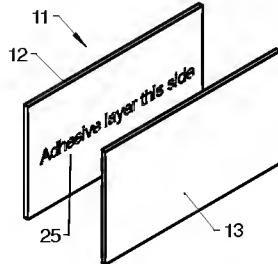
12. The following sets out Applicants understanding of the relevant parts of the disclosure of Heimann.

View in same direction as

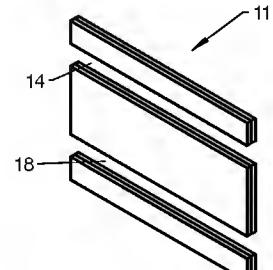
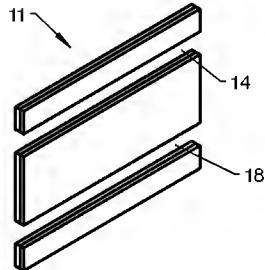
Figure 1 of Heimann

View from other side

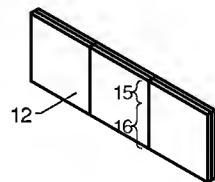
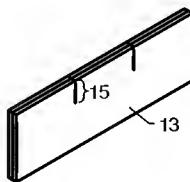
13. Col. 3, ll. 18-23 describes that the index tab 10 is cut ... from a format sheet 11 consisting of a sheet material 12 coated with a pressure-sensitive adhesive layer 25 and a backing sheet 13.



14. Col. 3, ll. 24-26 explains that the format sheet 11 is cut into strips by the cutting lines 14 and 18.



15. The document goes onto say from line 26 that the cutting lines 16 and 15 are defining individual label portions 19 from the adhesive coated material 12, the cutting lines 15 going also through the backing sheet 13.



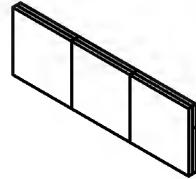
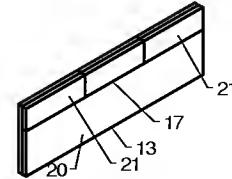
16. In other words, cutting lines 16 go only through the adhesive coated material 12, but the cutting lines 15 go through both the adhesive coated material 12 and the backing sheet 13.

View in same direction as

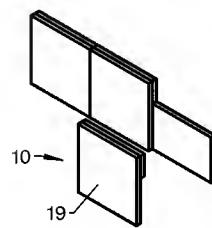
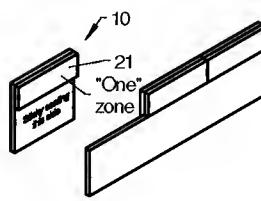
Figure 1 of Heimann

View from other side

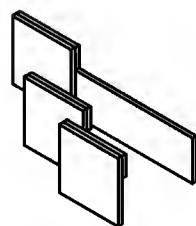
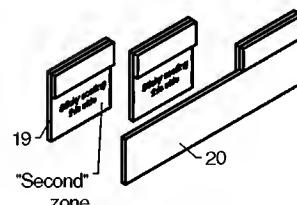
17. The document continues by saying from col. 3, line 29 that a cutting line 17 is designed to divide the backing sheet 13 into a supporting protective strip 20 and an index portion 21.



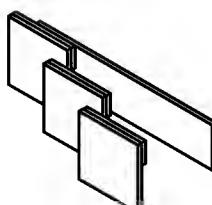
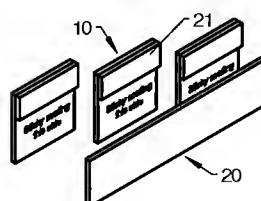
18. The document continues by saying from line 33 that in this manner index tabs 10 are provided side-by-side, each having a label portion 19 provided on one side and over one zone thereof, with an index portion 21.



19. Col. 3, l. 36: The continuous supporting strip 20 is, by virtue of its adhesive repelling face, removably attached to second zones of successive label portions 19.



20. Col. 3, l. 42: The index tab 10 may easily be removed from the supporting strip 20 by gripping the tab at the portion 21 and pulling it away from the supporting strip 20.



21. The Examiner has suggested that Heimann discloses pockets. Applicant submits that it does not. It discloses index tabs 10 that have no resemblance to pockets.

22. Claim 1 as currently amended defines the back panels as being connected by their edges edge-to-edge in a strip. By contrast, in Heimann, the index tabs 10 are not connected by their edges, which are separated by the cutting lines 15,16. Instead, in Heimann, the index tabs 10 are connected by the supporting strip 20 edge-to-edge in a strip.

23. The Examiner has suggested that Heimann discloses back panels that are sufficiently brittle that they can readily be snapped apart along the separation lines. Applicant submits that there is no disclosure or suggestion whatsoever of brittleness or the ability to snap apart in Heimann. Assuming that the Examiner is equating the label portions 19 of Heimann with the back panels of claim 1, Applicant submits that the label portions 19 of Heimann are not brittle and that it would be impossible to snap them apart along the separation lines, because the label portions 19 are already separated along the separation lines by the cutting step described at column 3, lines 26-29, of Heimann.

24. The combination of Rettig and Heimann therefore fails to disclose or suggest:-

- anything defining a separation line between adjacent pockets (or index tabs) along which those pockets (or index tabs), which are otherwise connected by their edges, can be readily separated; or
- back panels that are sufficiently brittle that they can readily be snapped apart along such a separation line.

25. Accordingly, Applicant submits that the skilled person would not consider combining the teachings of Rettig and Heimann, but even if the teachings were combined, the combination would fail to possess all the features defined in claim 1.

Claims 5 and 10 to 13 generally

26. Claims 5 and 10 to 13 have also been rejected as being obvious from Rettig in view of Heimann. These claims are each dependent on claim 1, and each is distinguished from Rettig in view of Heimann at least by the features discussed above in connection with claim 1.

Claim 12 in particular

27. Furthermore, Claim 12 as amended defines a further such strip, the strips being connected by their edges edge-to-edge and being readily separable from each other. Rettig does not disclose or suggest this feature. Heimann does show, in Figures 7 and 8, a series of strips of index tabs 10 arranged edge-to-edge. However, the strips are not connected by their edges, but are separated by the cutting lines 14,18.

Claim 14

28. Independent claim 14 has been rejected as being obvious from Rettig in view of Heimann. Applicant submits that claim 14 as previously presented was not obvious from Rettig in view of Heimann. However, an amendment has been made to claim 14 as currently presented to distinguish claim 14 more clearly from Rettig in view of Heimann.

29. Again, the Examiner has suggested that Rettig fails to disclose the feature of claim 1 that the back of the strip is self-adhesive, and Applicant points out that the telephone number holder 10 of Rettig is attached to the handset of the telephone by an adhesive strip 35.

30. Applicant concurs with the Examiner that Rettig fails to disclose the features of claim 1 of “means defining lines between adjacent pockets along which those pockets can be readily separated”, “a series of backing pieces each covering the self-adhesive back of a respective one of the pockets” and “each backing piece being peelable from the respective pocket to expose the self-adhesive back of the respective pocket.”

31. In alleging obviousness, Applicant again submits that there must be a demonstrable reason as to why the skilled person would wish to modify the prior art so as to meet the terms of the claim. Applicant submits that there is no such reason.

32. First, the holder of Rettig is designed to be stuck to a telephone handset. Applicant again submits that all telephone handsets are generally the same size, and that the skilled person would see no need to change the size of the holder of Rettig by facilitating the removal of one or more of the pockets.

33. Furthermore, Applicant submits that, given that there is no need to modify the holder of Rettig by facilitating the removal of one or more of the pockets, there is no apparent reason for providing a separate backing piece for each pocket. To do so would render the uncovering of the adhesive layer 36 more laborious, because the user would need to peel off all of the individual packing pieces individually, rather than peeling off a single backing strip in one operation.

34. In alleging obviousness by combining prior art teachings, Applicant understands that the combination must result in the claimed subject matter. Applicant submits the combination of Rettig and Heimann does not result in the arrangement as claimed in claim 14.

35. The Examiner has suggested that Heimann discloses pockets. Applicant again submits that it does not. It discloses index tabs 10 that have no resemblance to pockets.

36. Claim 14 as currently amended defines the back panels as being connected by their edges edge-to-edge in a strip. Again, by contrast, in Heimann, the index tabs 10 are not connected by their edges, which are separated by the cutting lines 15,16. Instead, in Heimann, the index tabs 10 are connected by the supporting strip 20.

37. The Examiner has suggested that Heimann discloses a series of backing pieces each covering the self-adhesive back of a respective one of the pockets. With reference to the discussion above of Heimann in relation to claim 1, Applicant submits that Heimann discloses a single self-adhesive backing (the supporting strip 20) that covers the self-adhesive portions of all of the index tabs 10 in the strip, and that there is no disclosure or suggestion whatsoever of an individual backing piece for each index tab 10. Indeed, if Heimann has an individual backing piece for each index tab 10, there would then be nothing to hold the index tabs together,

38. The combination of Rettig and Heimann therefore fails to disclose or suggest:-

- anything defining a separation line between adjacent pockets (or index tabs) along which those pockets (or index tabs), which are otherwise connected by their edges, can be readily separated; or
- backing pieces each covering the self-adhesive back of a respect one of the pockets (or index tabs).

39. Accordingly, Applicant submits that the skilled person would not consider combining the teachings of Rettig and Heimann, but even if the teachings were combined, the combination would fail to possess all the features defined in claim 14.

Claims 15 to 21 generally

40. Claims 15 to 21 have also been rejected as being obvious from Rettig in view of Heimann. These claims are each dependent on claim 14, and each is distinguished from Rettig in view of Heimann at least by the features discussed above in connection with claim 14.

Claim 15 in particular

41. Dependent claim 15 includes the limitation that each backing piece is a piece of writing material of a size such that it can be inserted into the respective pocket. The Examiner has stated that Heimann discloses this, but it does not. As discussed above in connection with claim 14, Heimann does not disclose individual backing pieces, let alone that they are of a size that they can be inserted into the pockets of Rettig.

Claim 16 in particular

42. Dependent claim 16 includes the limitation that the strip is flexible and is readily tearable along the separation lines. The Examiner has stated that Heimann discloses this, but it does not. In Heimann, the series of index tabs 10 cannot be readily torn along lines between them, because they are already cut along those lines by the cutting lines 15,16.

Claim 17 in particular

43. Dependent claim 17 includes the limitation that the back panels are integrally formed and are sufficiently brittle that they can readily be snapped apart along the separation lines. The Examiner has stated that Heimann discloses this, but it does not. As discussed above in connection with claim 1, there is no disclosure or suggestion in Heimann of brittleness and snapping apart.

Claim 20 in particular

44. Furthermore, like claim 12, claim 20 as amended defines a further such strip, the strips being connected by their edges edge-to-edge and being readily separable from each other. Rettig does not disclose or suggest this feature. Heimann does show, in Figures 7 and 8, a series of strips of index tabs 10 arranged edge-to-edge. However, the strips are not connected by their edges, but are disjointed by the cutting lines 14,18.

Corresponding patents in other countries

45. Applicant's corresponding foreign patents GB2401347B, GB2401348B, and EP1623404B have been granted.

46. The main claims of GB2401347B and EP1623404B correspond in scope to claim 14 of the present application. The main claim of GB2401348B corresponds in scope to claim 1 of the present application.

Conclusion

47. Applicant believes that she has responded fully to all of the matters raised in the office action and that all of the claims of the application are allowable. A notice of allowance is therefore respectfully solicited.

Respectfully submitted

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